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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,682	10/05/2001	Jerome Fournier	Q66648	1857

7590 12/29/2004

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Washington, DC 20037-3213

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/970,682

Applicant(s)

FOURNIER ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 19, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The rejection of claims 1-2, 4-7, 10, 12, 17-18, and 20 under 35 U.S.C. 102(b) as being anticipated by Podola et al, 5,525,654 is moot in view of applicant's amendments.

The rejection of claim 19 under 35 U.S.C. 103(a) as being unpatentable over Podola et al, 5,525,654 is moot in view of applicant's amendments.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaopo et al, 769,287 (Zaopo) in view of Keane et al, 4,503,124 (Keane), for reasons of record. Regarding the ability to withstand partial discharges, Keane teaches that the addition of his filler material provides resistance against discharges.

### ***Response to Arguments***

Applicant's arguments filed October 4, 2004 have been fully considered but they are not persuasive.

Applicants argue that the present invention belongs to the field of winding wires aimed at withstanding partial discharges, whereas the primary reference Zaopo is entirely silent about the resistance to partial discharge of the varnish it discloses, further arguing that the skilled artisan would never look into the general prior art related to

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varnishes that do not deal with the partial discharge phenomenon, and therefore, the skilled artisan would not find Zaopo, which, even though it may deal with varnishes for wire, is entirely silent about the behavior of such varnishes in the presence of partial discharges.

In response thereto, it is the examiner's position that "in Winslow "Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor", but is does not require us to presume full knowledge by the inventor of prior art outside the field of his endeavor, i.e. of the "non-analogous" art. In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonable pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains." *In re Antle*, 170 USPQ 285, 287, (CCPA 1971). Accordingly, it is the examiner's position that the general field of insulated cables, conductors and wires, (Zaopo) is well within applicants' field of endeavor and is an art area that is reasonably pertinent to applicant's because this field includes insulating wires to be used as coils or winding wires. One would reasonable expect the skilled artisan to first look to the field of wire, cable, conductor coatings and insulation and further, to those compounds within this field that are known additives in the reduction of discharge, regardless of the end usage of the final product, whether it is a winding wire, coil or electric cable.

Therefore, the examiner's position remains that the combined teachings of Zaopo and Keane would have rendered obvious the invention as claimed in present claims 1-17 and 20.

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Claims 19 and 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

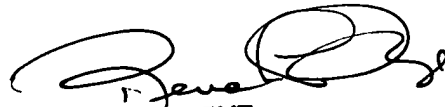
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray  
Examiner  
Art Unit 1774

jmg



RENA DYE  
SUPERVISORY PATENT EXAMINER

A.U. 1774

12/23/04